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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,330	01/28/2005	Werner Wittke	20793/0204712-US0	5747
<div>7278      7590      06/27/2007</div> <div>DARBY &amp; DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770</div> <div>EXAMINER KIM, TAEYOON</div> <div>ART UNIT      PAPER NUMBER</div> <div>1651</div> <div>MAIL DATE      DELIVERY MODE</div> <div>06/27/2007      PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/523,330

Applicant(s)

WITTKKE ET AL.

Examiner

Taeyoon Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-32 is/are pending in the application.
- 4a) Of the above claim(s) 15-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/28/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 15-32 are pending.

#### ***Election/Restrictions***

Applicant's election without traverse of Group II (claims 27-32) in the reply filed on May 9, 2007 is acknowledged.

Claims 15-26 are withdrawn from consideration as being drawn to non-elected subject matter. Claims 27-32 have been considered on the merits.

#### ***Information Disclosure Statement***

The information disclosure statement filed Jan. 28, 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609, because proper English translations for two references (A14 and A15) were not provided. In the IDS filed, applicant indicated to refer the International search report. Although the international report filed as an IDS reference A17 discloses A1, there is no disclosure for the description of the contents (abstract and/or main body written in English for consideration) for the reference. It has been placed in the application file, but the information referred to those two references has not been considered as to the merits. As for the reference A15, applicant indicated that the specification discusses the reference. However, it is not proper to rely on the specification for IDS reference to consider. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the

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statement, including all certification requirements for statements under 37 CFR 1.97(e).

See MPEP § 609.05(a).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "frame-like" in claims 27-32 is not clear what the subject matter the term intended to point out.

The term "substantial form" in claims 27-32 is a relative term which renders the claim indefinite. The term "substantial" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It could be interpreted as a glass, or a plastic container for storage, or a round-shaped container. The term "substantial" does not provide any specific standard to figure out the limitation.

Claim 32 recites the limitation "the method in claim 15" in 1<sup>st</sup> line. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 27-32 are rejected under 35 U.S.C. 102(a) as being anticipated by Schutze (WO/2002/014833; IDS reference A11, which is corresponding to US 2003/0180941).

Claims 27-32 are drawn to a method for laser microdissection comprising steps of 1) providing a frame-like holder with an opening at a bottom, 2) disposing a laser light-absorbing film on the holder to cover the opening, 3) disposing a biological preparation on the film, and 4) directing a cutting, focused laser beam onto the biological preparation (claim 27); a limitation to the step of directing being performed from above the biological preparation (claim 28); a limitation to the laser light-absorbing film being freely suspended (claim 29); a method for laser microdissection comprising steps of 1) providing a frame-like holder with an opening at a bottom, 2) disposing a laser light-absorbing film on the holder to cover the opening, 3) disposing a biological preparation on the film, and 4) cutting out the preparation and collect into a collection container underneath the biological preparation (claim 30); a limitation to the laser light-absorbing film being freely suspended (claims 31 and 32).

Schutze teaches a method of microdissecting living cells in culture using the carrier device (see paragraph [0024]). The carrier device of Schutze is configured as a frame (see Abstract), comprising a holder in the form of a Petri cup (paragraph [0012]), having a cylindrical main body (paragraph [0021]), and a laser light absorbent membrane (paragraph [0026]), disposed at the bottom of the cup by adhesive bonding

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(paragraphs [0004] and [0005]). Thus, the steps of the method in claims 27-32 are inherently met by the method of Schutze using the carrier device.

The limitation of "the laser light-absorbing film is freely suspended" in claims 29, 31 and 32 are inherently met by the configuration of the laser light absorbent membrane of Schutze because the membrane is attached at the edge of the membrane to the holder while the most of membrane in the middle not being contacted with any other object, thus being freely suspended.

Thus, the reference anticipates the claimed subject matter.

### ***Conclusion***

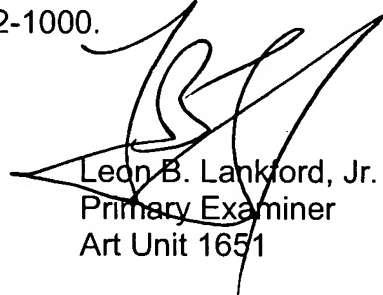
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taeyoon Kim whose telephone number is 571-272-9041. The examiner can normally be reached on 8:00 am - 4:30 pm ET (Mon-Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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